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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,558	03/31/2000	Alan H. Karp	10992073	9395

22879 7590 05/20/2003

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/539,558

Applicant(s)

KARP ET AL.

Examiner

Jonathan Ouellette

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 4/2/2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/539,558 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. Claims 1-20 have been cancelled; Claims 21-41 have been added; Claims 21-41 are now pending in application 09/539,558.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-31 and 33-41 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neil et al. (US 5,987,440).
5. As per independent Claims 21 and 34, O'Neil discloses a method (system) for selling personal information of an owner to a requestor comprising: obtaining the personal information of the owner by an information source (Abstract, C61 L50-54, C65 L36-39); providing the personal information to a trusted party by the information source after

authorization by the owner, wherein the trusted party is different from the owner; providing the personal information to a requestor by the trusted party based on a sale policy that is controlled by the owner (Abstract, C2 L49-63, C6 L53-64, C61 L61-67, C62 L61-67, C63 L1-15, C65 L39-40); providing payment to the trusted party from the requestor; and providing compensation to the owner from the trusted party (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).

6. As per Claim 22, O'Neil discloses wherein the trusted party and the information source are the same entity (Abstract, C2 L2-64, C61 L50-54, C65 L36-39).
7. As per Claim 23, O'Neil discloses specifying the sale policy by the owner (Abstract, C10 L11-16, C24 L8-45, C65 L50-55, C67 L7-10).
8. As per Claims 24 and 35, O'Neil discloses specifying attributes required of a requestor in order to receive the personal information (Abstract, C10 L11-16, C24 L8-45, C65 L50-55, C67 L7-10).
9. As per Claims 25 and 36, O'Neil discloses specifying exclusions related to the sale of the personal information (Abstract, C24 L8-45, C67 L7-10).
10. As per Claims 26 and 37, O'Neil discloses specifying cost of the personal information by the owner, and wherein the providing the personal information to a requestor comprises selectively providing the validated personal information based upon the cost (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C61 L55-60).
11. As per Claims 27 and 38, O'Neil discloses assessing the cost to a requestor submitting the request (Abstract, C6 L53-64, C21 L37-62, C24 L8-45).

12. As per Claims 28 and 39, O'Neil discloses crediting a least a portion of the cost to the owner (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).
13. As per Claim 29, O'Neil discloses crediting an account associated with the owner (Abstract, C6 L53-64, C21 L37-62, C24 L8-45, C62 L61-67).
14. As per Claims 30 and 40, O'Neil discloses obtaining information related to credit card purchases, shopping habits, web browsing habits, assets, or finances of the owner (Abstract, C6 L53-64, C10 L23-36).
15. As per Claims 31 and 41, O'Neil discloses recording an indication of electronic purchases by the owner (C6 L53-64, C10 L23-36, C21 L59-62, C63 L34-38).
16. As per Claim 33, O'Neil discloses receiving a request to search for a particular owner having personal information for sale by the trusted party (C20 L1-20, C24 L18-25, Figs. 28-33)

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 32 are rejected under 35 U.S.C. 103(a) as being obvious over O'Neil et al.
19. As per Claim 32, O'Neil discloses enabling the requestor to decline receipt of the personal information based upon a cost of the personal information; and wherein providing the personal information to the requestor comprises providing the personal information to the requestor if the requestor has not declined receipt of the personal information.

20. O'Neil does not specifically disclose enabling the requestor to decline receipt of the personal information based upon a cost of the personal information.
21. However, O'Neil does teach that the buyer (requestor) has the right to collectively bargain collective and individual personal information processing privileges in exchange for value (C67 L62-67, C68 L1-5).
22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included enabling the requestor to decline receipt of the personal information based upon a cost of the personal information in the system disclosed by O'Neil, for the advantage of providing a method for selling personal information, which gives the buyer bargaining power to decide whether to purchase the personal information or not based on the seller's price.

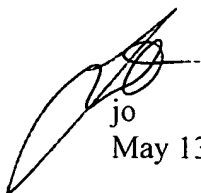
Conclusion

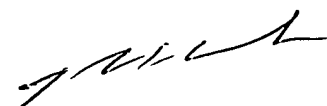
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

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May 13, 2003


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
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